

REMARKS

A. Finality of Office Action

The Office Action of May 24, 2004 has been made final. Applicant traverses this determination. In particular, in the previous Office Action of September 8, 2003, claims 56-65 were allowed. Applicant's Amendment filed on February 9, 2004 did not amend claims 56-65. Now, the May 24, 2004 Office Action has finally rejected claims 56-65 under 35 U.S.C. § 103 as being obvious in view of Klein et al. The finality of the rejection is improper since Applicant's Amendment of February 9, 2004 was not the cause for the new rejection based on Klein et al. See MPEP § 706.07(a). Accordingly, the finality of the Office Action should be withdrawn.

B. Objection to Drawings

In the Office Action of May 24, 2004, FIGS. 5, 6 and 9-15 were objected to for not being clearly readable. Applicant traverses this objection in that the figures in question are clearly readable. This is evidenced that the Examiner did not object to the clarity of the figures in question in the three previous Office Actions. Furthermore, the Office Action has not explicitly stated what is not clear in the drawings. Since the burden is on the Examiner to show that the drawings are not clearly readable and that burden has not been met, the objection is improper. Despite the impropriety of the objection, formal drawings are being filed concurrently with the present Response and so the objection should be withdrawn.

C. 35 U.S.C. § 102

1. Claims 1, 2, 4, 5 and 7

Claims 1, 2, 4, 5 and 7 were rejected under 35 U.S.C. § 102(b) as being anticipated by Klein et al. Applicant traverses this rejection for several reasons. First, Klein et al. was granted

on May 6, 2003 and the present application was filed on February 8, 2001. Since Klein et al. was not granted more than one year prior to the present application's filing date of February 8, 2001, the rejection under Section 102(b) is improper and should be withdrawn.

Assuming for arguments sake that Klein et al. qualifies as prior art, then the rejection is improper because claim 1 recites a planar area that moves parallel to a first direction and below a web of a substrate, wherein "said web moves substantially independently of said planar area and said web lies upon said planar area" (emphasis added). The Office Action asserts that the web 216 lies upon a planar area 202 as shown in Fig. 5. However, Fig. 5 shows that web 216 lies above and spaced from the conveyor belt 202. Such an orientation between the web 216 and the belt 202 cannot be considered to be that the web 216 is upon belt 202, since the word "upon" means "on" which in turn "is used as a function word to indicate position in or in contact with an outer surface" and so there must be some sort of contact between the web 216 and belt 202 for the web to be upon the belt. See the enclosed pages 823-824 and 1296 of Webster's Ninth New Collegiate Dictionary. Accordingly, claim 1 is not anticipated by Klein et al.

Besides not being anticipated by Klein et al., claim 1 is not rendered obvious by Klein et al. since there is no motivation to have Klein et al.'s web 216 lie upon the belt 202. In particular, Klein et al. teaches away from having web 216 lie upon belt 202 since there must be a spacing between web 216 and belt 202 so that the articles 204, 206, 208 and 210 can pass therebetween so that labels 218 can be placed on the top surface of the articles.

2. Claims 3 and 6

Claims 3 and 6 were rejected under 35 U.S.C. § 102(b) as being anticipated by Klein et al. Applicant traverses this rejection for several reasons. First, Klein et al. was granted on May

6, 2003 and the present application was filed on February 8, 2001. Since Klein et al. was not granted more than one year prior to the present application's filing date of February 8, 2001, the rejection under Section 102(b) is improper and should be withdrawn.

Assuming for arguments sake that Klein et al. qualifies as prior art, then the rejection is improper because claim 3 recites a web of a substrate that moves along a first direction and a dispensing system that includes "a planar area that moves parallel to said first direction and below said web" (emphasis added). The Office Action asserts a planar area 202 moves parallel to the web 216 as shown in Fig. 5. However, Fig. 5 shows that web 216 moves either at an angle relative to conveyor belt 202 (see portion between reel 214 and peel tip 220) or in a direction generally opposite to the conveyor belt 202 (see portion between peel tip 220 and roll 222). Since conveyor belt 202 does not move parallel to the direction of web 216, claim 3 is not anticipated by Klein et al. and so the rejection is improper and should be withdrawn.

3. Claims 34-38

Claims 34-38 were rejected under 35 U.S.C. § 102(b) as being anticipated by Klein et al. Applicant traverses this rejection for several reasons. First, Klein et al. was granted on May 6, 2003 and the present application was filed on February 8, 2001. Since Klein et al. was not granted more than one year prior to the present application's filing date of February 8, 2001, the rejection under Section 102(b) is improper and should be withdrawn.

Assuming for arguments sake that Klein et al. qualifies as prior art, then the rejection is improper since claim 34 recites a process wherein a web of a substrate is moved along a first direction and a planar area is moved parallel to the first direction and below the web. The Office Action asserts a planar area 202 moves parallel to the web 216 as shown in Fig. 5. However, as

pointed out above in Section C.2 this is not the case. Accordingly, the rejection is improper and should be withdrawn.

D. 35 U.S.C. § 103

1. Klein et al. and Pinchen et al.

Claim 8 was rejected under 35 U.S.C § 103 as being obvious in view of Klein et al. and Pinchen et al. Claim 8 depends indirectly on claim 1. Pinchen et al. does not solve the deficiencies of Klein et al. in that Pinchen et al. does not suggest altering Klein et al. so that web 216 lies upon belt 202. Without such suggestion, the rejection is improper and should be withdrawn.

2. Klein et al. and Chamberlain et al.

a. Claims 9-15 and 26-29

Claims 9-15 and 26-29 were rejected under 35 U.S.C § 103 as being obvious in view of Klein et al. and Chamberlain et al. Claims 9-15 and 26-29 depend directly or indirectly on claim 1. Chamberlain et al. does not solve the deficiencies of Klein et al. in that Chamberlain et al. does not suggest altering Klein et al. so that that web 216 lies upon belt 202. Without such suggestion, the rejection is improper and should be withdrawn.

b. Claims 39 and 50

Claims 39 and 50 were rejected under 35 U.S.C § 103 as being obvious in view of Klein et al. and Chamberlain et al. Claims 39 and 50 depend directly or indirectly on claim 34. Chamberlain et al. does not solve the deficiencies of Klein et al. in that Chamberlain et al. does not suggest altering Klein et al. so that Klein et al.'s planar area 202 moves parallel to the web 216. Without such suggestion, the rejection is improper and should be withdrawn.

3. **Klein et al., Chamberlain et al. and Barber et al.**

a. **Claims 16-32**

Claims 22-32 were rejected under 35 U.S.C § 103 as being obvious in view of Klein et al., Chamberlain et al. and Barber et al. Claims 22-32 depend directly or indirectly on claim 1. Chamberlain et al. and Barber et al. each does not solve the deficiencies of Klein et al. in that Chamberlain et al. and Barber et al. each do not suggest altering Klein et al. so that Klein et al.'s web 216 lies upon belt 202. Without such suggestion, the rejection is improper and should be withdrawn.

b. **Claims 40-41 and 45-51**

Claims 40-41 and 45-51 were rejected under 35 U.S.C § 103 as being obvious in view of Klein et al., Chamberlain et al. and Barber et al. Claims 40-41 and 45-51 depend directly or indirectly on claim 34. Chamberlain et al. and Barber et al. each do not solve the deficiencies of Klein et al. in that Chamberlain et al. and Barber et al. each do not suggest altering Klein et al. so that Klein et al.'s planar area 202 moves parallel to the web 216. Without such suggestion, the rejection is improper and should be withdrawn.

c. **Claims 43 and 44**

Claims 43 and 44 were rejected under 35 U.S.C § 103 as being obvious in view of Klein et al., Chamberlain et al. and Barber et al. Independent claim 43 recites a process wherein a web of a substrate is moved along a first direction and a planar area is moved parallel to the first direction and below the web. The Office Action asserts a planar area 202 moves parallel to the web 216 as shown in Fig. 5. However, as pointed out above in Section C.2 this is not the case. Chamberlain et al. and Barber et al. each do not solve the deficiencies of Klein et al. in that

Chamberlain et al. and Barber et al. each do not suggest altering Klein et al. so that Klein et al.'s planar area 202 moves parallel to the web 216. Without such suggestion, the rejection is improper and should be withdrawn.

d. Claim 52

Claim 52 was rejected under 35 U.S.C § 103 as being obvious in view of Klein et al., Chamberlain et al. and Barber et al. Claim 52 recites wherein a web of a substrate is moved along a first direction and a planar area is moved parallel to the first direction and below the web. The Office Action asserts a planar area 202 moves parallel to the web 216 as shown in Fig. 5. However, as pointed out above in Section C.2 this is not the case. Chamberlain et al. and Barber et al. each do not solve the deficiencies of Klein et al. in that Chamberlain et al. and Barber et al. each do not suggest altering Klein et al. so that Klein et al.'s planar area 202 moves parallel to the web 216. Without such suggestion, the rejection is improper and should be withdrawn.

e. Claims 60-64

Claims 60-64 were rejected under 35 U.S.C § 103 as being obvious in view of Klein et al., Chamberlain et al. and Barber et al. Claims 60-64 depend directly or indirectly on claim 65. Chamberlain et al. and Barber et al. each do not solve the deficiencies of Klein et al. pointed out below in Section D.5 in that Chamberlain et al. and Barber et al. each do not suggest altering Klein et al. so that Klein et al. moves its planar area 202 parallel to the web 216. In addition, Chamberlain et al. and Barber et al. each does not suggest altering Klein et al. to diminish skewing of a portion of web 216. Without such suggestion, the rejection is improper and should be withdrawn.

4. **Klein et al. and Barber et al.**

a. **Claims 16-21 and 30-32**

Claims 16-21 and 30-32 were rejected under 35 U.S.C § 103 as being obvious in view of Klein et al. and Barber et al. Claims 16-21 and 30-32 depend directly or indirectly on claim 1. Barber et al. does not solve the deficiencies of Klein et al. in that Barber et al. does not suggest altering Klein et al. so that Klein et al.'s web 216 lies upon belt 202. Without such suggestion, the rejection is improper and should be withdrawn.

b. **Claim 34**

Claims 34, 42 and 51 were rejected under 35 U.S.C § 103 as being obvious in view of Klein et al. and Barber et al. Claim 34 recites a process wherein a web of a substrate is moved along a first direction and a planar area is moved parallel to the first direction and below the web. As pointed out above in Section, C.2, Klein et al. does not disclose that its planar area 202 moves parallel to the web 216. Since Barber et al. does not suggest altering Klein et al. so that Klein et al.'s planar area 202 moves parallel to the web 216, the rejection is improper and should be withdrawn.

c. **Claim 59**

Claim 59 was rejected under 35 U.S.C § 103 as being obvious in view of Klein et al. and Barber et al. Claim 59 depends directly on claim 65. Barber et al. does not solve the deficiencies of Klein et al. mentioned below in Section D.5 in that Barber et al. does not suggest altering Klein et al. so that Klein et al.'s planar area 202 moves parallel to the web 216. In addition, Barber et al. does not suggest altering Klein et al. to diminish skewing of a portion of web 216. Without such suggestion, the rejection is improper and should be withdrawn.

5. Klein et al.

Claims 56-58 and 65 were rejected under 35 U.S.C § 103 as being obvious in view of Klein et al. Independent claim 65 recites a process for manufacturing a label that includes moving a web of a substrate along a first direction and diminishing skewing if a portion of the web by “moving a planar portion parallel to said first direction.” As mentioned above in Section C.2, Klein et al. does not disclose or suggest moving its planar area 202 parallel to the web 216. In addition, Klein et al. does not disclose or suggest diminishing skewing of a portion of web 216. Accordingly, the rejection is improper and should be withdrawn.

E. Claim 33

Applicant notes that claim 33 has not been rejected and so Applicant assumes that the claim has been deemed to contain allowable subject matter. Claim 33 is being amended in independent form. Accordingly, claim 33 should be allowed.

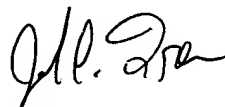
As mentioned above claim 33 has been amended to be in independent form. Since the amendment incorporates subject matter that is inherently present in the claim, the amendment is not being made for reasons related to patentability as defined in *Festo Corporation v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd*, 234 F.3d 558, 56 USPQ2d 1865 (Fed. Cir. 2000) (*en banc*), *overruled in part*, 535 U.S. 722 (2002).

CONCLUSION

In view of the arguments above, Applicant respectfully submits that all of the pending claims 1-52 and 56-65 are in condition for allowance and seek an early allowance thereof. If for any reason, the Examiner is unable to allow the application in the next Office Action and believes that an interview would be helpful to resolve any remaining issues, he is respectfully

requested to contact the undersigned attorneys at (312) 321-4200.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "J.C. Freeman", written in a cursive style.

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